

## REMARKS

### **I. General**

Claims 1-18 are pending in the present application. Claims 1, 2, 8, 9, 13, and 18 stand rejected under 35 U.S.C. § 102. Claims 3-7, 10-12, and 14-17 stand rejected under 35 U.S.C. § 103. Applicant respectfully traverses the rejections of record.

Paragraph 0024 has been amended to correct a typographical error discovered during the preparation of the present Amendment. Specifically, an erroneous reference to station 201-1 has been amended to correctly reference station 201-2. No new matter has been added.

### **II. The 35 U.S.C. § 102 Rejections**

Claims 1, 2, 8, 9, 13, and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Averbuch et al., United States patent number 5,867,785 (hereinafter *Averbuch*). However, to anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Applicant respectfully asserts that the disclosure of *Averbuch* does not meet the foregoing requirements with respect to the rejected claims.

To aid the Examiner in understanding the present invention, attention is directed to the specification at paragraphs 0008-0011 wherein an embodiment is described as follows:

The intelligent wireless switch coordinates wireless communications between the plurality of wireless devices and wireless access points. . . . The intelligent wireless switch enables substantially continuous wireless communications to occur by successively associating with exterior wireless access points through its plurality of wireless stations. [W]hen the intelligent wireless switch first detects an access point, one of the plurality of stations associates with that access point. . . . When another access point is detected by the intelligent wireless switch, the other [wireless] station associates with the second access point. . . . At this point, the [wireless] stations of the intelligent wireless switch are associated with two different access points. [T]he intelligent wireless switch detects [a] reduction in received signal from the access point [and i]n response thereto, the intelligent wireless switch routes data associated with the wireless devices to the second access point using the second [wireless]

station. Because a connection already exists with the second access point, the handoff is transparent to the plurality of wireless devices.

Accordingly, operation of the described embodiment provides “make before break” connection with external access points using a plurality of wireless stations of the wireless switch. The plurality of wireless devices (e.g., user devices) communicate with the wireless switch, and thus communicate with external access points, through a wireless station of the wireless switch, see paragraph 0008.

Claim 1 sets forth various aspects consistent with the foregoing embodiment of the invention. For example, claim 1 recites “associating a station of a wireless switch with said first access point” and “associating a second station of said wireless switch with a second access point . . . .” In rejecting the claim, the Examiner relies upon item 203 of *Averbuch* as showing associating a first station of a wireless switch with a first access point and item 206 of *Averbuch* as showing associating a second station of a wireless switch with a second access point, the Office Action at page 2. Applicant points out that item 203 is a mobile base site providing communication between mobile communication unit 209 and mobile system controller 200, see column 4, lines 1-8, and Figure 2. Item 203 of *Averbuch* is more akin to the above mentioned wireless switch access point than the recited station, and thus is taught to be associated with a mobile communication unit rather than an access point.

Further distinguishing the invention of claim 1 over the system disclosed in *Averbuch* is the claim language reciting “monitoring signal strengths of said first and second access points as received by said first and second stations . . . .” As pointed out above, item 203 of *Averbuch* receives signals from the mobile communication unit rather than an access point, thereby presenting an arrangement in which it does not appear possible to monitor the signal strength of a first access point as received by item 203. Clearly, the elements of *Averbuch* relied upon in the rejection of record are not arranged as required by the claim.

Additionally, *Averbuch* does not teach or suggest monitoring signal strengths of first and second access points and “switching to routing data between said plurality of wireless devices and said second access point using said second station in response to said monitoring.” In contrast to the recited invention, *Averbuch* teaches that mobile system controller 200 communicates with a single access point (stationary base site) at any one time

using repeater or base station 206, being handed off from access point to access point serially by stationary system controller 101, see column 4, lines 8-14, and column 8, lines 41-48. In contrast to the claimed invention, the signal monitoring performed by mobile system controller 200 of *Averbuch* is to determine which communication resources (channels) of the stationary network may be used by mobile system controller 200 within common carrier transportation device 115 without the communication resources assigned to stationary base sites substantially interfering with the communications in common carrier transportation device 115, see column 5, line 63, through column 6, line 9, and column 12, lines 47-50. Accordingly, claim 1 and the claims dependent therefrom are patentable over *Averbuch* under 35 U.S.C. § 102.

Claim 9 recites “a plurality of stations for communicating with external access points . . . .” The rejection of record relies upon the mobile communication units of *Averbuch* to meet the recited stations communicating with external access points, see the Office Action at page 3. However, these same mobile communication units have also been relied upon to meet the plurality of wireless devices set forth in the claim, *id.* The mobile communication units of *Averbuch* cannot be read to meet both of these different claim elements.

Moreover, claim 9 expressly recites “routing data between said plurality of wireless devices and external access points using said plurality of stations . . . .” It becomes very clear that reading mobile communication units as meeting both the recited plurality of wireless devices and plurality of stations does not present elements arranged as required by the claim. In the context of *Averbuch*, it is nonsensical to suggest that mobile communication units route data to external access points using mobile communication units.

Claim 9 recites that the “packet switch controller is operable to switch communications between said plurality of stations in response to signal strengths received from said plurality of access points crossing threshold values.” As discussed above with respect to claim 1, *Averbuch* teaches that mobile system controller 200 communicates with a single access point (stationary base site) at any one time using repeater or base station 206, being handed off from access point to access point serially by stationary system controller 101, see column 4, lines 8-14, and column 8, lines 41-48. Accordingly, claim 9 and the claims dependent therefrom are patentable under 35 U.S.C. § 102 over *Averbuch*.

Claim 13 recites “a wireless switch comprising[] a plurality of stations for communicating with said plurality of access points . . . .” The rejection of record relies generally upon Figure 2 of *Averbuch* to meet the recited stations communicating with external access points, see the Office Action at page 3. However, Figure 2 shows only a single repeater or base site 206 which communicates with the access points (stationary base sites).

Although Applicant has addressed the aspect of *Averbuch* shown in Figure 2 believed to be most analogous to the recited “stations for communicating with said plurality of access points,” if the Examiner intended to rely upon some other aspect of *Averbuch* in rejecting the claim Applicant respectfully points out that the rejection of record does not comport with Office policy. Specifically, the Examiner is directed that “[i]n accordance with the patent statute, ‘Whenever, on examination, any claim for a patent is rejected , or any objection . . . made’, notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given,” M.P.E.P. § 707. As such the Examiner has not “clearly articulate[d] any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity,” M.P.E.P. §706. Applicant therefore requests that the Examiner set forth detail of the grounds for rejection with respect to claim 13 in order that Applicants may have a full and fair opportunity to explore the patentability of this claim.

Claim 13 recites “a packet switch controller for directing data between said plurality of stations and said plurality of wireless devices, wherein said packet switch controller switches between said plurality of stations in response to signal strengths received from said plurality of access points.” As discussed above with respect to claim 1, *Averbuch* teaches that mobile system controller 200 communicates with a single access point (stationary base site) at any one time using repeater or base station 206, being handed off from access point to access point serially by stationary system controller 101, see column 4, lines 8-14, and column 8, lines 41-48. Accordingly, claim 13 and the claims dependent therefrom are patentable over *Averbuch* under 35 U.S.C. § 102.

### III. The 35 U.S.C. § 103 Rejections

Claims 3 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Averbuch* in view of Chia, United States patent number 5,396,253 (hereinafter *Chia*). Claims 4, 10, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Averbuch* in view of Shostak, United States patent application publication number 2004/0043797 (hereinafter *Shostak*). Claims 5, 6, 14, 15, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Averbuch* in view of Noll et al., United States patent application publication number 2003/0153316 (hereinafter *Noll*). Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Averbuch* in view of Haumont et al., United States patent application publication number 2001/0012279 (hereinafter *Haumont*). Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Averbuch* in view of *Haumont* and further in view of Gresham et al., United States patent application publication number 2002/0160773 (hereinafter *Gresham*). Applicant respectfully traverses the 35 U.S.C. § 103 rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicant respectfully asserts that the rejections of record fail to meet the foregoing criteria.

Initially, Applicant points out that *Averbuch* does not meet the limitations of base claims 1, 9, and 13, as shown above. Each of claims 3-7, 10-12, and 14-17 depend directly or indirectly from a respective one of claims 1, 9, and 13. As the secondary and tertiary references are not relied upon in curing the deficiencies identified above with respect to *Averbuch*, claims 3-7, 10-12, and 14-17 are asserted to be patentable at least for the reasons set forth above with respect to claims 1, 9, and 13.

Moreover, the system of *Averbuch* is so fundamentally different than that set forth in the claims, whether or not various aspects of these claims are present in the secondary and

tertiary references is immaterial to the patentability of the claims in view of *Averbuch*. For example, *Averbuch* does not teach a “make before break” connection with the stationary base sites using a plurality of stations of a wireless switch. Accordingly, even assuming *arguendo* that *Shostak* teaches maintaining a connection by communicating ping packets (e.g., claims 4, 10, and 17), such a feature cannot be integrated into *Averbuch* without substantial unsuggested modification. Similarly, even assuming *arguendo* that *Haumont* teaches receiving packets by a first station and transmitting acknowledgment packets by a second station (e.g., claims 7 and 12), such a feature cannot be integrated into *Averbuch* without substantial unsuggested modification.

Applicant further asserts that the proffered statements of motivation with respect to the 35 U.S.C. § 103 rejections of record are insufficient to establish a *prima facie* case of obviousness. For example, in rejecting claims 3 and 11, the Office Action states that “it would be obvious to one of ordinary skill in the art [sic: at] the time of invention to use the method except wherein said monitoring comprises: applying a filtering function to received signal strengths [because t]his modification improves accuracy of the signal strength estimate during a deep fade,” the Office Action at page 4. The language of the recited motivation is circular in nature, stating that it is obvious to make the modification (add signal filtering) because it is obvious to achieve the result (obtain an improved, filtered, signal). Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

In rejecting claims 4, 10, and 17, the Office Action states that “it would be obvious to one of ordinary skill in the art [sic: at] the time of invention to maintain a connection with said second access point by communicating ping packets through said second access point [because t]his modification helps in speeding up the handover process,” the Office Action at page 5. The foregoing statement of motivation is flawed for at least two reasons. Initially, Applicant points out that it is the connection with the second access point which helps in

speeding up the handover process, not how that connection may be maintained. The Examiner has asserted that *Averbuch* alone meets claim 1 reciting both the first and second connection. Accordingly, if the Examiner's assertion with respect to *Averbuch* were correct there would be no need to modify *Averbuch* in view of *Shostak* or any other reference in order to "help[] in speeding up the handover process." As the hypothetical person skilled in the art can summarily be described as one who thinks along lines of conventional wisdom in the art and as being neither one who undertakes to innovate nor one who has the benefit of hindsight, Applicant asserts that if such a person were to read *Averbuch* consistent with the Examiner's assertions that person would not find it obvious to maintain a connection with a second access point by communicating ping packets.

Moreover, it is well settled that the prior art must suggest the desirability of the claimed invention, M.P.E.P. § 2143.01. Neither *Averbuch* nor *Shostak* detail such desirability. The motivation supplied in the Office Action is derived from the Applicant's disclosure, see paragraph 0011. The teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure, see M.P.E.P. §2143, citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Thus, the motivation to combine provided by the Examiner is improper, as the motivation must be described in a prior art reference and must detail the benefits of such a modification.

In rejecting claims 5, 6, 14, 15, and 16, the Office Action states that it would have been obvious to one of ordinary skill in the art to make the proffered modifications because the "modification[s] improve[] the communication efficiency," the Office Action at pages 6 and 7. The Examiner has not provided an objective reason to combine the teachings of the references. See M.P.E.P. 2142.01. The reason provided by the Examiner—i.e., "to improve the communication efficiency," is a general incentive, and not an objective reason. Applicant points out that "[a] general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out," *In re Deuel*, 51 F.3d 1552, 1559 (Fed. Cir. 1995). Therefore, the motivation provided by the Examiner for modifying *Averbuch* in view of *Noll* is improper.

In rejecting claim 12, the Office Action states that "it would be obvious to one of ordinary skill in the art at the time of invention to use wireless system, wherein when said

packet switch controller switches communications between a first station to a second station, said switch controller distributes remaining packets received by said first station to said plurality of wireless devices and send acknowledgment packets through said second station [because t]his modification prevents the second access points from sending duplicate packets,” the Office Action at page. The language of the recited motivation is circular in nature, stating that it is obvious to make the modification (send acknowledgement packets to a second access point) because it is obvious to achieve the result (to avoid the second access point sending duplicate packets when no acknowledgment is received). As discussed above, such language is merely a statement that the reference can be modified, and does set forth motivation establishing the desirability for making the modification as required for a proper rejection under 35 U.S.C. § 103.

In rejecting claim 7, the Office Action states that “it would be obvious to one of ordinary skill in the art at the time of invention to use wireless system, wherein the packets from the first access point that are associated with transmission control protocol (TCP) sessions [because t]his modification helps in accessing Internet through mobile devices,” the Office Action at page 9. Assuming *arguendo* that the use of TCP may help in accessing the Internet through mobile devices, the rejection of record does not identify any objective reason as to why one of ordinary skill in the art would have desired to modify *Averbuch* to access the Internet. Thus, the motivation to modify *Averbuch* in view of *Haumont* and further in view of *Gresham* provided by the Examiner is insufficient to establish *prima facie* obviousness under 35 U.S.C. § 103.

#### **IV. Summary**

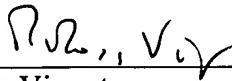
In view of the above, Applicant believes the pending application is in condition for allowance. Accordingly, Applicant respectfully requests that the Examiner pass the claims to issue.



Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 64032/P015US/10404210 from which the undersigned is authorized to draw.

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Respectfully submitted,

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